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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/782,412	02/13/2001	Gary P. Mousseau	1400-1072 D5	3123
47243	7590	07/17/2006	EXAMINER	
DANAMRAJ & YOUST, P.C. PREMIER PLACE, SUITE 1450 5910 NORTH CENTRAL EXPRESSWAY DALLAS, TX 75206			REILLY, SEAN M	
			ART UNIT	PAPER NUMBER
			2153	

DATE MAILED: 07/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.		Applicant(s)	
	09/782,412		MOUSSEAU ET AL.	
	Examiner		Art Unit	
	Sean Reilly		2153	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 March 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 65-118 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 65-118 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. <u>6/8/06</u> |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>3/22/06</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This Office action is in response to Applicant's amendment and request for reconsideration filed on March 22, 2006. New claims 65-118 are presented for further examination.

Information Disclosure Statement

1. The information disclosure statement (IDS) submitted on March 22, 2006 is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 65-118 are rejected under 35 U.S.C. 103(a) as being unpatentable over by Eggleston et al. (U.S. Patent Number 5,958,006; hereinafter Eggleston) and Kikinis (U.S. Patent Number 5,964,833).

With regard to claims 65, 79, 97, and 108, Eggleston disclosed a method of redirecting e-mail messages and message attachments to a user of a mobile data communication device that is

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associated with a host system and communicates therewith via a wireless gateway, the method comprising the steps of:

Receiving a data item (email) at the host system (server 115) from a message sender, the data item being directed to an address associated with the user at the host system (address of mobile user 105), the data item including an e-mail message and a message attachment (e.g. email message with attachment, Col 8, lines 30-37);

Redirecting at least a portion of the e-mail message from the host system to the mobile data communication device via the wireless gateway using a network address of the mobile data communication device (e.g. when the user has implemented a filter and only part of the message is sent to the user, see inter alia Col 3, lines 23-26 and Col 10, lines 10-32);

Receiving a first command message from the mobile data communication device at the host system requesting more of the data item (i.e. sends the request after receiving partial or summary data for more of the message or all of the message, see inter alia Col 3, lines 29-34 or Col 10, line 57 – Col 11, line 4);

Redirecting the message attachment from the host system to the mobile data communication device via the wireless gateway using the network address of the mobile data communication device in response to first command message (i.e. when the user requests all of the message or full transfer of the message, the attachment will also be sent to the user's mobile device, again see inter alia Col 3, lines 29-34 or Col 10, line 57 – Col 11, line 4);

Eggleston disclosed substantial features of the claimed invention including providing typical email functions to mobile users (e.g. compose, reply, and forward). However, Eggleston failed to specifically recite receiving a second command message from the mobile data

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communication device at the host system to send the message attachment to an external device and redirecting the message attachment from the host system to the external device in response to the second command message. Nonetheless such functionality would occur when a user forwarded an email message containing an email attachment to another mobile user, as would typically occur during email use. The claimed second command is equated with the user's forward command (i.e. user decides forward an email with an attachment) that is sent to the server and the claimed external device is equated the intended mobile recipient of the forwarded message including the attachment. The user would typically perform such a forwarding function in order to convey pertinent information contained in an email or email attachment to another mobile user.

Thus, it would have been obvious to a user of ordinary skill in the art at the time of Applicant's invention to utilize the traditional email forwarding command in Eggleston's system to forward an email containing an attachment to another mobile user, in order to convey information to other users. Again such a traditional email forward command would naturally result in receiving a second command message from the mobile data communication device at the host system to send the message attachment to an external device and redirecting the message attachment from the host system to the external device in response to the second command message.

Furthermore it was widely known in the art at the time of Applicant's invention to forward email attachments to external devices other than e-mail recipient devices, as evidenced by at least Kikinis. In a similar messaging system Kikinis disclosed a system that allows users to forward email attachments to various preprogrammed external devices such as a fax machine

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(Kikinis Col 4, lines 50-56). By allowing users to forward attachments using other devices rather than just email, Kikinis allows users to communicate easier and with more people. For instance an external device such a fax machine may be more convenient for some users or the only form of communication available to other users who are unable to receive email at a particular location. Thus, it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to modify Eggleston's system to allow users to forward attachments to other preprogrammed external devices, as disclosed by Kikinis, so that users can communicate with other people by using different means rather than just email and thus communicate with more people.

With regard to claim 66, Kikinis disclosed providing a user profile for the mobile data communication device, wherein the user profile stores a list of one or more external device associated with the mobile data communication device (i.e. preprogrammed external devices such as a fax machine, Kikinis Col 4, lines 50-56).

With regard to claims 67, Eggleston disclosed:

Configuring one or more redirection events at the host system (e.g. user sets up a filter, see inter alia Col 8, lines 14-55);

detecting that a redirection event has occurred at the host system (i.e. an email passes the filter criteria) and generating a redirection trigger (required internally in the system such that the system invokes the process or procedure to actually forward the message); and

In response to the redirection trigger, redirecting at least a portion of the e-mail message from the host system to the mobile data communication device (i.e. forwarding the message when it passes the filter criteria).

With regard to claims 68 and 69, Eggleston disclosed the external redirection event is a message from the mobile data communication device to start the redirection step (i.e. user enables the filters from the mobile device, Col 9, lines 32-43). Eggleston also disclosed the internal event includes a calendar alarm (calendar activates a filter profile, Col 9, lines 42-43).

With regard to claims 70, Eggleston disclosed the mobile data communication device is one of a hand-held wireless paging computer, a wirelessly-enabled palm-top computer, a mobile telephone with data message capabilities and a wirelessly-enabled laptop computer (Col 4, lines 11-13).

With regard to claims 71, Examiner takes official notice that word processing files, audio files, and video files, were all widely known types of files to save and transfer information at the time of Applicant's invention. Furthermore it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to send these types of files as attachments in order to transfer information between users.

With regard to claims 72 and 73, Examiner takes official notice that word processing files often could be processed (i.e. displayed) by mobile devices such as the mobile station MS of

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Eggleston's system and further video files often could not be processed by mobile devices due to their constrained resources. Thus, in view of the official notice taken in claim 71, the message attachment could is a type that the mobile communication device can process (i.e. work processing file) and cannot process (video file).

With regard to claim 75, Kikinis disclosed the external device is one of a fax machine (Col 4, lines 50-56).

With regard to claim 76, Kikinis disclosed the step of decoupling the message attachment from the e-mail message (i.e. Kikinis only sends the attachment to a fax machine which requires decouple the message attachment from the e-mail message).

With regard to claim 77, Kikinis disclosed the step of storing the e-mail message and message attachment in a message store at the host system (Col 4, lines 38-48).

Dependent claims 80-88, 90-96, 98-107, and 109-118 are rejected using a similar rationale as applied to claims 66-78.

Conclusion

3. The prior art made of record, in PTO-892 form, and not relied upon is considered pertinent to applicant's disclosure.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

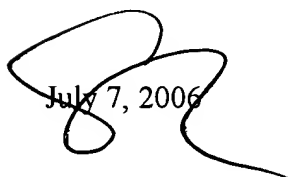
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sean Reilly whose telephone number is 571-272-4228. The examiner can normally be reached on M-F 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glen Burgess can be reached on 571-272-3949. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

 July 7, 2006


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